REMARKS

This Amendment is submitted in response to the Office Action of November 9, 2004 (hereinafter "the Office Action"). Upon entry of this Amendment, claims 1-7 and 9-20 will be canceled without prejudice, claim 8 amended, and new claims 21-29 submitted. Therefore, claims 8 and 21-29 will be pending, including newly submitted claims 21-29.

In this Amendment, all references to the claims, except as noted, will be made with reference to the claim list above beginning on page 3. All references to "the Office Action," except as noted, will be referencing the most recent Office Action dated November 9, 2004. Line numbers in the Office Action, except as noted, will count every printed line, except the page header, but including section headings. Explanations of prior art references are based on the undersigned's best understanding thereof. If there is any confusion or questions regarding any aspect of this Amendment, the Examiner is invited to contact the undersigned.

Background

The present invention relates to a software system for tracking and managing compatibility testing of a Java technology (or other software product) to ensure compliance with an input specification. For example, the input specification may describe in detail a Java technology such as the application programming interfaces (APIs) for the Java technology. APIs are mechanisms allowing a computer programs to talk to each other and to an operating system. In a Java implementation, the API interfaces allow a java program (which is cross-platform and therefore not aware of the particular operating system platform it is running on) to use existing functions and operations provided by the operating system.

The reference implementation is a working implementation of the specific technology to prove that the specification can be implemented. The Test Compatibility Kit mentioned in the present Application is used to test implementations for compliance with the input specification. More information on this technology can be obtained from the Assignee's web site, and particularly at "http://java.sun.com/developer/technicalArticles/JCPtools/".

Amendment

The specification is amended to correct minor informalities noted while reviewing the application. Claims 1-7 and 9-20 are canceled without prejudice. Claim 8 is amended to better set forth novel aspects of the invention. Claims 21-29 are added.

Specifically, the preamble of claim 8 is amended to identify the invention relates to a specification compatibility tracking system, as identified by the title of the present Application. Claim 8 is further amended to provide "a code segment that associates testable assertions with statements within the input specification" (lines 5-7). This is supported by Figure 6 and the paragraph bridging pages 24 and 25 of the written description (paragraph 76 of the published application). Claim 8 further is amended to provide "a code segment that binds each testable assertion to one of a plurality of tests that test the testable assertion, each one of the tests being a computer program testing an implementation of the software product to ensure that the software product complies with the portion of the input specification as corresponding with the testable assertion bound to the one of the tests" (lines 8-12). The term "test" is explained in page 4 lines 3-9 of the specification (paragraph 10 of the published application). Binding of a test to an assertion is discussed in page 12 lines 1-12 (paragraphs 32-33 of the published application).

Claim 8 further sets forth, "a code segment that identifies each testable assertion as tested, non-tested, or invalid" (lines 13-14). This is described on page 25, lines 22-23 (paragraph 78 of the published application). Finally, claim 8 sets forth, "a code segment for presenting information on coverage of the input specification by tests" (lines 15-16). This is described in lines 3-15 of page 26 of the written description (paragraph 79 of the published application).

Claims 21-23 are also supported in lines 3-15 of page 26 of the written description (paragraph 79). Claim 24 is supported by page 12 lines 1-6 of the specification (paragraph 32 of the published application). Claims 25-29 contain similar limitations to claims 8 and 21-24 and are supported by the same portions of the specification.

No new matter has been entered by this Amendment.

Claim Rejections - 35 U.S.C. § 112, first paragraph

Claims 1, 3-9, 11-15, and 17-20 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Applicants respectfully traverse. An enablement rejection under 35 U.S.C. § 112 requires a showing that the inventor was not in possession of the claimed invention at the time the invention was made. Applicants respectfully submit that, for the reasons discussed below, the claims are fully supported by the specification, and that the specification enables a person having ordinary skill to make and use the claimed invention.

With regard to the claim rejections, Applicants have canceled (without prejudice) claims 1, 3-7, 9, 11-15, and 17-20, thereby obviating any rejection thereagainst. Claim 8 has

been amended to remove reference mentioned in the paragraph bridging pages 2 and 3 of the Office Action. Applicants respectfully submit that since the rejected claims are either canceled or amended to obviate the rejection, the rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn.

However, Applicants will take this opportunity to address the criticisms of the specification made in the Office Action. The Office Action, from page 3 line 1 to page 4 line 14, discusses several portions of the specification, and suggests that these selected portions fail to set forth an enabling disclosure. It is agreed that the portions of the specification selected by the Examiner do not adequately set forth the operation of the invention. However, the specification should be read as a whole, and the pertinent issue in determining enablement is not whether the portions selected by the Examiner provide an enabling disclosure. See MPEP 2153.II.A.2.

For example, the Office Action, page 3, lines 5-12 quotes "paragraph 63" of the specification as identified in the published application (US 2002/0198868), which corresponds to the first paragraph of page 21 of the application as filed. This paragraph discusses what a testable assertion is, and is not intended to teach how to extract testable assertions from a specification. The explanation as to how the testable assertion is extracted is made in the paragraph bridging pages 23 and 24 of the application as filed. This corresponds to paragraph 73 of the published application document. That paragraph discloses the mechanism whereby the testable assertions may be extracted. It should be noted that for enablement, it is not required that the mechanism work flawlessly 100% of the time. Furthermore, since the specific feature of automatically extracting testable assertions from the input specification is no longer claimed, the issue is moot. Other specific issues noted in the Office Action are likewise no longer at issue because of the cancellation and amendment of the claims.

Claim Rejections -- 35 U.S.C. § 112, second paragraph

Claims 1, 3-9, 11-15 and 17-20 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention (Office Action, page 5, lines 6-8). In particular, the Office Action states that the term "assertion" is inadequately defined (Office Action, page 5, lines 17-19). Applicants respectfully traverse because either the term is adequately defined in the specification and/or because the rejected claim has been canceled thereby obviating the rejection.

The Office Action states, "As best examiner is able to ascertain, Applicant defines assertion as a testable statement within a specification. For purposes of this examination,

examiner assumes that assertion is a statement within a specification" (Office Action page 5, lines 19-21). The Office Action is correct in determining that the term "assertion" is not used in the present Application to refer to the programming technique of testing assumptions in computer programs. The term "assertion" as used in the present Application is clearly defined in the specification page 6 lines 21-22 (paragraph 16 of the published application). The term "assertion" should not be interpreted as, "a statement in the specification" as indicated in the Office Action (see quote above). Assertions may be extracted from statements in the specification, but there is not necessarily a one-to-one correlation between statements in the specification and assertions.

With regard to claims 1, 3-7, 9, 11-15, and 17-20, these claims have been canceled without prejudice thereby obviating any rejection laid against them.

With regard to claim 8 and remaining claims, since the specification clearly and consistently uses the term "assertion" to mean a testable statement, Applicants respectfully submit that the term is adequately defined. Furthermore, the claims have been modified to use the term "testable assertion" to more clearly set forth the intended meaning of the term.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 3, 4, 8, 15, and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,954,826 issued to Herman et al. (Herman). Applicants respectfully traverse.

Claim 1 sets forth a system for ensuring compatibility of a particular Java technology with a particular input specification including, *inter alia*, "a code segment that associates testable assertions with statements within the input specification; a code segment that binds each testable assertion to one of a plurality of tests that test the testable assertion. . . ." Independent claim 25 has a similar limitation. In contrast, Herman shows a software product for analyzing a computer program to ensure that it is supported by a specific impelementation of Java. Specifically, Herman analyzes a computer program and determines what references cannot be resolved within the application, and for those references, whether or not the input specification contains programming resources that can be used to resolve those references. See col. 4, lines 17- 27. Herman does not teach associating testable assertions with statements within input specification or binding each testable assertion to test case.

Since Herman does not teach or suggest, alone or in combination with other cited references, the presently claimed invention, Applicants respectfully submit that the rejection under 35 U.S.C. § 102 should be withdrawn.

For the reasons discussed above Applicants respectfully submit that the present Application is now in condition for Allowance. A Notice of Allowance is therefore respectfully requested.

If the Examiner has any questions concerning the present amendment, the Examiner is kindly requested to contact the undersigned at (408) 774-6933. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP013). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
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